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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/649,977

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Akihiro Yanagita

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FRASER CLEMENS MARTIN & MILLER LLC
28366 KENSINGTON LANE
PERRYSBURG, OH 43551

EXAMINER

CHEN, BRET P

ART UNIT

PAPER NUMBER

1762

MAIL DATE

DELIVERY MODE

05/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/649,977	Applicant(s) YANAGITA ET AL.	
	Examiner B. Chen	Art Unit. 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 19-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-25 are pending in this application.

Election/Restrictions

Applicant's election without traverse of claims 1-18, 25 in the reply filed on 7/27/06 is acknowledged.

Claims 19-24 have been withdrawn from consideration as being directed to a nonelected invention.

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

It is noted that the claimed invention is directed solely to a method. The examiner suggests amending the title to reflect same.

Claim Observations

It is noted that the claims contain reference characters corresponding to elements enclosed in parentheses. While they are acceptable per MPEP 608.01(m), the claims are not being limited to the reference characters and the use of same has no effect on the scope of the claims. It is suggested that applicants remove the extraneous reference characters to avoid any potential confusion.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-18, 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In claim 1, the phrase “determining a theoretical value” is deemed nonenabling as the specification does not provide any guidance as to how one does this. It is noted that the theoretical value as presently recited can be anything. As a result, determining a theoretical value appears to be irrelevant. For example, one skilled in the art can assign a value of 1 or 10 or 100 or 1000. Are all values acceptable? It is not the examiner’s intention to be condescending about this issue but wishes merely to have the applicant’s limitation clarified. The same issue applies to claim 25.

In claim 1, the phrase “determining a first new value for the compensation factor” is deemed nonenabling as to how one skilled in the art would determine a new compensation factor. For example, if the initial value were 100, how does the skilled artisan decide on the new value? Could it be 10 or 1000? If it can be any value, what is the purpose of determining the initial value? The same issue applies to determining a second value. Again, as stated above, it is not the examiner’s intention to be belligerent about this issue. The same issue applies to claim 25. Clarification and appropriate amendments are requested.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18, 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase “measuring a pressure of the viscous material” is deemed vague and indefinite as to what said phrase means. The examiner understands how one can measure the temperature of a material. But how does one measure the pressure of a material and is it different from the pressure of the system? Clarification is requested.

In claim 1, the phrase “determining a theoretical value” is deemed vague and indefinite. It is noted that the theoretical value as presently recited can be anything. If the applicant intended for this, applicant should say so on the record and this rejection will be withdrawn. If not, however, any guidance as to what this theoretical value is should be incorporated in the claim. The same issue applies to claim 25.

In claim 1, the phrase “determining a first new value for the compensation factor” is deemed vague and indefinite as to what said phrase means. How does one determine a new value? Clarification is requested. The same issue applies to claim 25.

In claim 8, the phrase “establishing a cracking pressure” is deemed vague and indefinite as to what said term means. It is not clear what the cracking pressure has to do with the dispensation of the viscous material. The same issue applies to “establishing a linearity factor” in claim 9.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-18, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Putt (6,329,013). Putt discloses a method for dispensing a viscous solution by utilizing a dynamic flow control system which consists of a dosing system controlled by means of a computer unit and consists of at least one pressure part, a material container, a nozzle, and a pressure member displaceable in the material container (col.1 lines 5-12). In one embodiment, a test sequence is run before the dispensing operation and during the test sequence data is collected mainly about the dosing unit including the pressure within at least one pressure part, the position of the pressure member of the dosing unit, and a material feed pressure by the computer unit, a set value is determined for a material feed pressure and a material flow substantially with regard to the collected data and the material is dispensed with regard to the set value for flow controlled by means of a regulator, as a direct value of the set flow value and at the same time the application flow is controlled (col.3 lines 33-45). It should be noted that Putt specifically teaches of determining a set value for a material feed pressure and a material flow substantially in respect of

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collected data and applying the material with regard to the set value by controlling the dispensed flow (lines 35-40). Also, the computer unit can measure the volume of the dosing unit from a sensor and regulate the pressure with the pressure member (lines 40-45). The control unit 15 is arranged with a number of inputs and outputs, for collecting data as well as for generation and transmitting control signals and may be controlled by the robot or another external control unit (col.4 lines 25-42) and controls a regulator 16 utilized to control the material flow (col.4 lines 43-61). The reference teaches the use of a pulse transducer (col.4 lines 5-19). However, the reference fails to specifically teach a compensation factor.

It is noted that the reference clearly teaches of measuring a value and comparing it with a set value and modifying a deposition parameter as a result and repeating. One skilled in the art would realize that the claimed compensation factor is merely what the computer would be assigned a value and results in an additional step with a more precise way of obtaining a specific parameter. It would have been obvious to utilize a compensation factor with the expectation of obtaining a more precise process of dispensing a material.

The limitations of claims 2-18 and 25 have been addressed above.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to B. Chen whose telephone number is (571) 272-1417. The examiner can normally be reached on 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Bc
5/22/07



BRET CHEN
PRIMARY EXAMINER